

**REMARKS**

Applicant wishes to thank the Examiner for the consideration given this case to date. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. As examined, Claims 1-7 and 9-12 were pending. As amended, Claims 1-7 and 9-12 remain pending and new claims 13 and 14 have been added. No new matter is believed introduced.

**THE EXAMINER'S ACTION**

In the Office Action, the Examiner:

1) rejected claims 1-7, 9 and 10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

2) rejected claims 1-7, 9 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3) rejected claim 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,484,574 to DeRusha et. al. ("DeRusha"); and

4) rejected claims 1-3, 5, 7 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,895,153 to Johnston et al. ("Johnston").

5) rejected claims 1-6 and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,508,084 to Reeves et al. ("Reeves").

6) rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,248,762 to Hornibrook et al. ("Hornibrook").

**REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Office now asserts that the specification does not reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Office contends that the term "substantially uniform" is not supported by the specification. Office Action p. 2. Further the Office questions different claims and disclosures that call for

“substantially uniform thickness” on one hand and “a textured surface” on the other hand. Id.

The written description requirement of 35 U.S.C. §112, first paragraph requires the application to “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the applicant was in possession of the invention.” Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The claimed subject matter need not be identically described in the specification in order to satisfy the written description requirement. In re Wright, 866 F.2d 422, 425. Indeed, the drawings alone may provide a sufficient description. Vas-Cath, at 1564. The test “is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed ....” Noelle v. Lederman, 355 F.3d 1343, 1348 (Fed. Cir. 2004), and Examiners are assumed to be familiar with the level of skill in the art. Am. Hoist & Derrick Co. v. Sowa & Sons, 725 F.2d 1350, 1359 (Fed. Cir. 1984).

Initially, Applicant notes that the claimed language has been pending for more than 5 years. In this time, it has been considered by a prior examiner, a panel of 3 examiners sitting as pre-appeal conferees, a panel of 3 Administrative Law Judges considering a fully briefed and answered appeal to the Board of Patent Appeals and Interferences, and attorneys in the Solicitors Office. None of these Office personnel have raised the concern that a person of ordinary skill in the art would NOT recognize that applicant possessed the “substantially uniform” polymer layer claimed. This is particularly relevant because Examiners are assumed to be familiar from their work with the level of skill in the art. Am. Hoist. While it is beyond reasonable dispute that the rejection is not timely, it is also inappropriate because prior Examiners familiar with the level of skill in the art and claim language appear to have recognized that the applicant possessed what is claimed.

Substantively, to assess whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed, applicant notes that the

claim is more specific than the questioned “substantially uniform” language. The substantially uniform thickness of the polymer layer may be defined by claim 1 itself, in that the claim calls for, among others, a “substantially uniform thickness of between about 0.020” and 0.065”....” In other words, this portion of the claim is self defining – substantially uniform means between about the forty-five thousandths of an inch range claimed.

Additionally, Applicant submits the Declaration of Joseph T. Mausar Under 37 C.F.R. 1.132 (filed herewith). Mr. Mausar reviewed the specification and figure and concluded that the statements in the specification at page 4 (relating to textured extruded polymer layer), page 5 (relating to thickness testing), and page 7 (charting the thickness testing results) when taken together with the Figure disclose that an artisan would recognize that the applicant possessed the claimed “substantially uniform” but textured polymer layer. Mausar Decl. ¶ 15.

Thus, a person of ordinary skill in the art would recognize that the applicant possessed what is claimed, satisfying §112, first paragraph.

#### **REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Office finds the phrase “substantially uniform” in claim 1 unclear, which is said to render that the claim and those depending therefrom unpatentably indefinite. The Office asks rhetorically how can a polymer layer have a uniform thickness while having a textured surface? Office Action p. 3.

Claims are considered indefinite under the second paragraph of 35 U.S.C. § 112 when they are not amenable to construction or are insolubly ambiguous. Hearing Components, Inc. v. Shure Inc., 600 F.3d 1357, 1366 (Fed. Cir. 2010). Thus, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning. Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed. Cir. 2005). If the meaning of a claim term is discernible, even though the conclusion may be one over which reasonable persons will disagree, the claim satisfies the definiteness requirements of 35 U.S.C §112, second paragraph. Id.

Claim 1 calls for, among others, a “substantially uniform thickness of between about 0.020” to 0.065”....” The claim thus clearly defines the “substantially uniform thickness” as being about 0.020” to 0.065”. As to the question of how the polymer layer can have, at once, both a “substantially uniform thickness” and a “textured surface,” Applicant notes that the plain meaning of the claim language merely requires that the “substantially uniform thickness” be between about 0.020” to 0.065”. Thus, a thickness - textured or otherwise - in the range meets the claim language.

Because the claim term, “substantially uniform,” can be given reasonable meaning in the context of claim 1, even if reasonable persons may disagree, the term meets the definiteness requirements of 35 U.S.C. §112, second paragraph.

#### REJECTIONS UNDER 35 U.S.C. § 102(b)

The Office contends that DeRusha anticipates claim 12. Office Action p. 4. However, the Examiner will appreciate that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*; citing Richardson v. Suzuki Motor Co., 868 F. 2d 1226, 1236 (Fed. Cir. 1989). Moreover, the elements must be arranged as required by the claim. *Id.*, citing In re Bond, 910 F. 2d 831 (Fed. Cir. 1990).

#### **DeRusha Fails to Disclose Application to a Flooring Environment**

Claim 12 calls for “An adhesive tape for application to a flooring environment” and an “adhesive layer [] disposed to adhere to the flooring environment....” (emphasis supplied).

DeRusha completely fails to disclose its tape on “a flooring environment.” The Office attempts to remedy this clear deficiency by observing that the “adhesive can attach to any substrate surface.” Office Action, p.4. However, the passage cited by the Office in support merely notes that “[t]he resulting tape...adheres strongly,

but releasably to virtually any clean, dry surface including glass, metal, fabric, plaster casts and human skin.” DeRusha, Column 5, lines 1-5 (emphasis added). This use of the phrase “virtually any” in the passage cannot be said to disclose the identical invention in as complete detail as required to support the rejection.

Moreover, the entire teaching of DeRusha repeatedly and exclusively discloses its tape as “wrapping” around its application area. For example DeRusha describes: (i) “the invention” as relating to a foam tape which may be used as a bandage hold down or athletic wrap. Column 1, lines 6 and 7 (emphasis supplied); (ii) the invention as particularly suitable for athletic applications where some flexibility of the wrapped member is desired. Column 2, lines 25 - 27 (emphasis supplied); (iii) the tape as useful to wrap around the limb of a mammal. Column 4, lines 34 - 44 (emphasis supplied); and (iv) the tape wrapped around the limb of a mammal and over an ankle joint in multiple overlapping layers. Column 5, lines 7 - 10 (emphasis supplied). In summary, the DeRusha wrapped areas simply cannot be said to describe the “flooring environment” limitation twice repeated by claim 12.

The Office also contends that the term “disposed,” as defined by Merriam-Webster’s, means “to give a tendency to.” Office Action, p.4. But this reasoning also fails under the analysis above. Even if “disposed” means “tends to,” nothing in DeRusha can be said to fairly suggest even a “tendency” to adhere to the flooring environment instead of the materials listed like glass, metal, fabric, plaster casts, or human skin. DeRusha, Column 5, lines 1-5.

DeRusha fails to show the identical invention in as complete detail as contained in the claim. For at least this reason, DeRusha does not anticipate claim 12. Reconsideration is requested.

#### REJECTIONS UNDER 35 U.S.C. § 103(a)

Applicant respectfully asserts that the obviousness rejections are improper. In one instance, the Office fails to make out a prima facie case of obviousness. In

another instance, the references applied are improperly not enabling for the teachings relied upon by the Office.

# **I. Johnston**

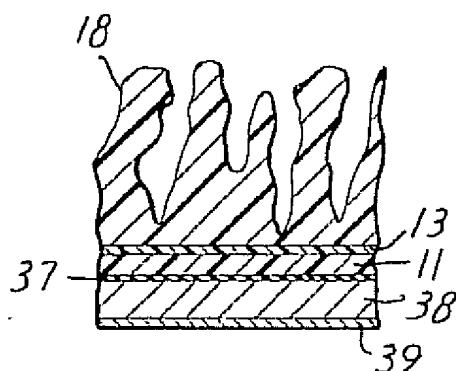
Claims 1-3, 5, 7 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnston. All words in a claim must be considered in judging the patentability of that claim against the prior art. (MPEP § 2143.03, citing In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970)). Because the Johnston analysis fails to consider all the claim limitations, a prima facie case has not been made.

## **A. Johnston Fails To Disclose A Polymer Layer Attached To An Adhesive Layer.**

Claim 1 calls for, among others:

“a polymer having a Shore A Hardness of between 92 and 100 ... and a layer of adhesive attached to said polymer layer.” (emphasis added).

The Office contends Johnston discloses an adhesive article that can be formed into any shape, (Abstract; Column 8, lines 16-20) comprising a polymer layer having a Shore A Hardness of between about 60 and 95 (Figures 4 and 6, reference #18, Column 4, lines 51-55) and a layer of adhesive attached to said polymer layer (Figure 6, reference #38). Office Action p. 5. A careful reading reveals that Johnston teaches a friction-surface sheet with multiple layers, including embossed layer #18 bonded to the thermoplastic polymer layer #13, that, in turn, is bonded to film #11. Film #11 is bonded to a pressure sensitive adhesive layer #38 that may be primed with a rubber primer layer #37. Finally, a release liner #39 protects the assembly. Johnston, Column 2, lines 44 – 58. Figure 6 of Johnston is reproduced below with a legend of reference numbers and descriptions from the specification:



- 18 – embossed layer / copolymer
- 13 – thermoplastic polymer primer
- 11 – film or backing layer
- 37 – prime coating / rubber
- 38 – pressure sensitive adhesive layer
- 39 – release liner

**FIG. 6**

Again, claim 1 requires the adhesive layer to be attached to “said polymer layer,” meaning the layer with the Shore A Hardness limitations. The Office identifies the adhesive layer as Johnston’s reference #38, and the polymer layer as Johnston’s embossed layer, reference #18. Assuming, arguendo that Johnston’s embossed layer #18 renders the claimed Shore A Hardness range obvious, the embossed polymer layer #18 is plainly not in contact with or attached to the adhesive layer #38. Rather, Johnston discloses at least film #11 preventing attachment of polymer #18 to adhesive #38.

Additionally, Applicant submits the Declaration of Joseph T. Mausar Under 37 C.F.R. 1.132 (filed herewith). Mr. Mausar reviewed Johnston and concluded that a person skilled in the art would not read Johnston’s disclosure as describing an adhesive layer attached to the polymer layer. Mausar Decl. ¶ 30.

For this reason alone, the rejection of claim 1 as obvious in light of Johnston is inappropriate because Johnston fails to teach each and every element claimed and the rejection fails to include some articulated reasoning with some rational underpinning to explain the deficiencies and support the legal conclusion of obviousness. Further claims 2, 3, 5, 7, 9 and 10 depend directly or indirectly from

claim 1, and should be deemed allowable at least to the extent that Johnston fails to teach the above limitations. In re Fine, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

**B. Johnston Fails To Disclose A Pressure Sensitive Adhesive In Direct And Uninterrupted Contact With The Polymer Layer.**

Claim 11 calls for, among others “a polymer layer ... and a layer of pressure sensitive adhesive ... being in direct and uninterrupted contact with the polymer layer....” (emphasis added).

The Office contends that Johnston teaches an adhesive tape that can be cut into any shape including a narrow strip or band, (Abstract; Column 8, lines 16-20) comprising a polymer layer (Column 4, lines 51-55, Figure 6, reference #18) and a layer of pressure sensitive adhesive (Figure 6, reference #38), being in direct and uninterrupted contact with the polymer layer. Office Action, p. 5.

As above, the rejection must be withdrawn because Johnston does not teach that polymer layer #18 (purported to have the required Shore A Hardness) is in direct and uninterrupted contact with the adhesive layer #38.

Additionally, Applicant submits the Declaration of Joseph T. Mausar Under 37 C.F.R. 1.132 (filed herewith). Mr. Mausar reviewed Johnston and concluded that a person skilled in the art would not read Johnston’s disclosure as describing an adhesive layer with one side in direct and uninterrupted contact with the polymer layer. Mausar Decl. ¶ 33.

A prima facie case of obviousness has not been made for claim 11 in light of Johnston for at least the reason that Johnston fails to teach each and every element claimed and the rejection fails to include some articulated reasoning with some rational underpinning to explain the deficiencies and support the legal conclusion of obviousness.

**II. Reeves**

Claims 1-6, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reeves. In order to render a claimed apparatus or method



obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989), citing, In re Payne, 606 F.2d 303, 314, (CCPA 1979). Even if a reference discloses an inoperative device, it is prior art for its enabled teachings. Id., (Prior art machine operated, and was thus enabled even if operation was sub-optimal); Therasense, Inc. v. Becton, Dickinson and Company, 593 F.3d 1289, 1298 (Fed. Cir. 2010), (prior art machine exhibiting very low oxygen sensitivity enables comparably sensitive machine). However, such disclosure does not render subject matter unpatentable if it is not sufficiently enabling, in other words, if it does not place the subject matter within "the possession of the public." In re Wilder, 429 F. 2d 447, 451 (CCPA 1970).

Because Reeves fails to place the disclosed Shore A hardness range in possession of the public, the rejection is improper and should be withdrawn.

**Reeves Fails To Disclose An Operative Shore Hardness Range Between 92 And 100.**

Claim 1 calls for, among others: "a polymer layer having a Shore A Hardness of between 92 and 100."

The Office contends that Reeves meets the above limitation by disclosing a Shore A Hardness of between about 70 and 140 (Column 14, lines 25-29). Office Action, pp. 7-8.

The Shore A Hardness scale is one of several scales to describe the relative hardness of a material. Mausar Decl. ¶ 36. The dimensionless value is determined with an instrument called a durometer under the control of an operator conducting standardized tests. Mausar Decl. ¶ 37-38. In brief, the durometer applies an indenter to a sample material being tested. Mausar Decl. ¶ 39-40. If the indenter completely penetrates the sample, a hardness of 0 is recorded. If no penetration occurs, a hardness reading of 100 results. Mausar Decl. ¶ 41. Therefore, the scale for Shore A Hardness ranges from 0 to 100. Mausar Decl. ¶ 36, 38, 41. A Shore A

Hardness range that exceeds 100, such as that described by Reeves, is meaningless. Mausar Decl. ¶ 43.

Reeves purports to disclose a hardness range of 70-140 Shore A. The described range exceeds the limits of the Shore scale for more than half of the range described. In other words, only the 30 units of hardness of between 70-100 of the range are possible. The 40 units of hardness above 100, that, is from 101-140 Shore A, are impossible. Mausar Decl. ¶ 45. Indeed, one skilled in the art would not be able to determine any valid teaching from Reeves as to what hardness range was intended. Mausar Decl. ¶ 46.

As such, because the teaching of Reeves hardness range of 70 – 140 Shore A does not place the subject matter within "the possession of the public" it is non-enabling and insufficient support for a rejection under 35 U.S.C. § 103. In re Wilder.

For at least the reason that Reeves fails to teach the claimed invention, the rejection is believed overcome. Further, claims 2-6, 9 and 10 depend directly or indirectly from claim 1, and should be deemed allowable at least to the extent that Johnston fails to teach the above limitations. In re Fine, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

### III. Hornibrook

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hornibrook. All words in a claim must be considered in judging the patentability of that claim against the prior art. (MPEP § 2143.03, citing In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970)). Because the Hornibrook analysis fails to consider all the claim limitations, a prima facie case has not been made.

#### Hornibrook Fails to Disclose Application to a Flooring Environment

Claim 12 calls for "An adhesive tape for application to a flooring environment" and an "adhesive layer [] disposed to adhere to the flooring environment...." (emphasis supplied).

Hornibrook includes absolutely no mention, suggestion or support for its decorative products to be used in “a flooring environment.” Indeed, the Office makes no showing that the claim element was even considered. The single use of the “flooring environment” term in the rejection is a mention in passing defining the term “disposed,” as meaning “to give a tendency to.” Office Action, p.11. But even if “disposed” indeed means “tends to,” nothing in Hornibrook or its analysis can be said to fairly suggest even a tendency to adhere to the flooring environment.

The rejection under Hornibrook fails to consider all the claim limitations. For at least this reason, the rejection is improper and should be reversed. Reconsideration is requested.

#### IV. New Claims 13 and 14

New claims 13 and 14 have been added as dependent claims from claim 12 and 1 respectively and add detail to the peel adhesion tests as recited in the specification as originally filed at page 6, first full paragraph. No new matter is believed included.

The new claims are believed patentable over the references of record for at least the following reasons.

DeRusha discloses a foam tape having a peel strength as measured by PSTC-1. Mausar Decl. ¶ 18. DeRusha's PSTC-1 test includes peeling the sample at a peel angle of 180 degrees after a dwell time of one minute. Mausar Decl. ¶ 19.

New claim 13 calls for the peel adhesion to be measured when peeling the tape at a 90 degree angle. A skilled artisan would expect peel adhesion to change upon a change in test peel angle. Mausar Decl. ¶ 23. Moreover, a skilled artisan would not interpret DeRusha's test as teaching the 90 degree angle claimed. Mausar Decl. ¶ 23.

Hornibrook discloses a peel adhesion test including a peel angle of 180 degrees. Mausar Decl. ¶ 49. Moreover, peel adhesion results change as test peel angles change. Mausar Decl. ¶ 51.

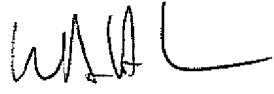
New claim 14 calls for a certain peel adhesion when tested at a 90 degree angle and a dwell time of one hour.

CONCLUSION

Applicant, intending to be completely responsive, believes that the amendments and remarks presented above resolve all outstanding issues on the above-referenced application. Accordingly, the application is believed to be in condition for allowance. Early notice thereof is earnestly solicited. While no additional fees are believed due, the Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 50-4883, referencing Attorney Docket No. 5923.0001.

Respectfully submitted,

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